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 conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer at a plurality of locations on said file folder.

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#### REMARKS

In the Office Action, the Examiner indicated that claims 35-38 would be allowed if rewritten in independent form. Applicants wish to thank the Examiner for kindly indicating the presence of allowable subject matter. By this Amendment, Applicants have rewritten claims 35, 36, and 38 in independent form, thereby placing claims 35-38 in condition for allowance.

With the Office Action, the Examiner attached the initialed PTO Forms 1449 that Applicants had submitted in various Information Disclosure Statements. It is noted that one of the references cited on one of the 1449 forms was neither crossed out nor initialed by the Examiner. A copy of this 1449 form is attached. Applicants respectfully request that the Examiner place his initials on this 1449 form to acknowledge consideration of the document referred to as a patent abstract of Japanese Publication No. 01098067

Also in the Office Action, the Examiner indicated that claims 2-11, 14-18, 20-22, 24-33, 39-53, and 55-63 are withdrawn from consideration based on a restriction requirement that was made final in the Office Action. Applicants wish to point out to the Examiner that a Petition Under 37 C.F.R. §1.144 to withdraw the restriction requirement was filed on

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October 9, 1998. Therefore, the Examiner may wish to defer further examination of this application until a decision is rendered on the Petition.

In the Office Action, the Examiner rejected claims 1, 12, 13, 19, 23, 34, and 54 under the judicially created doctrine of double patenting over claims 1-20 of U.S. Patent No. 5,751,221. Although Applicants respectfully traverse this rejection, Applicants have filed a Terminal Disclaimer concurrently herewith, disclaiming the terminal portion of any patent that may issue from this application that would extend beyond the term of U.S. Patent No. 5,751,221. Therefore, this rejection has been rendered moot. Applicants wish to point out that, to the extent they are required to file any divisional applications to pursue the restricted claims originally presented in this application, the claims of such divisional applications should not be subject to a double-patenting rejection over U.S. Patent No. 5,751,221. Insofar as the Examiner apparently considers all the claims of the '221 patent to define an invention that is not patentably distinct from the elected claims of this application and has indicated that the non-elected claims are patentably distinct from the elected claims, and the non-elected claims are apparently considered to be patentably distinct from the claims of the '221 patent (see 35 U.S.C. §121).

In the Office Action, the Examiner also rejected claims 1, 12, 13, 19, 23, 34, and 54 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,455,409 issued to Smith et al., U.S. Patent No. 4,376,936 issued to Kott, and U.S. Patent No. 5,287,414 issued to Foster. Applicants respectfully traverse this rejection for the reasons described below.

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Claims 1, 12, and 13

In the Office Action, the Examiner contends that one of ordinary skill in the art would have found the claimed invention to be obvious primarily in view of the Smith et al. and Kott references.<sup>1</sup> Specifically, the Examiner apparently contends that one of ordinary skill in the art would have found it obvious to modify the Smith et al. system so as to be useful for tracking file folders rather than computer tapes, while also modifying the system to utilize a central database rather than a distributed database. Additionally, the Examiner contends that it would have been obvious to have utilized the folders disclosed in Kott to store documents in a filing system that can locate the folders in the manner suggested by the Smith et al. patent. For the reasons discussed below, Applicants submit that the Examiner's contentions as to what one of ordinary skill would have been motivated to do as of the date of the present invention is based upon the hindsight reconstruction of the claimed invention. In other words, one of ordinary skill in the art would not have been motivated to construct a system including all the claimed components based solely upon the teachings of Smith et al. and Kott together or in combination with Foster.

To the extent the Examiner contends that one of ordinary skill in the art would have been motivated to construct a file tracking system that utilizes a central database and yet otherwise operates in accordance with the teachings of Smith et al., Applicants respectfully request the Examiner to state why one of ordinary skill in the art would have been motivated to

*Applicant's submission in location  
submitted by Smith et al.*

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<sup>1</sup>The Examiner's comments pertaining to the Foster patent did not relate to features recited in claim 1.

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X make such a modification to the Smith et al. tracking system. Clearly, Smith et al. discloses that the use of a central database in such tracking systems is *not equivalent* to the use of the distributed database utilized in the preferred embodiments, since Smith et al. describes many disadvantages to utilizing a central database (see column 4, lines 6-27). Thus, the modification suggested by the Examiner does not constitute a mere substitution of known equivalents. As pointed out in MPEP §2143, it is incumbent upon the Examiner to establish that one of ordinary skill in the art would have been motivated as of the time of the invention to make the contemplated modification. In the Office Action, the Examiner has not stated any motivation for modifying the Smith et al. tracking system to utilize a central database.

As stated in MPEP §2143.01 (page 2100-112 of the July 1998 edition), "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the *desirability* of the combination." [Emphasis added] *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner, however, has not made a showing as to why one of ordinary skill in the art, having considered the teachings of the Smith et al. and Kott references, would have considered it *desirable* to modify the Smith et al. tracking system so as to include a central database. To the contrary, one of ordinary skill in the art would have been dissuaded from making the contemplated modification because the Smith et al. reference clearly *teaches away* from such use of a central database.

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Applicants further submit that it is not at all clear how the Examiner contemplates modifying the Smith et al. tracking system to incorporate and track file folders such as those

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disclosed in Kott. For one of ordinary skill in the art to have been motivated to make such a combination, there clearly must have been some suggestion as to how the ordinarily skilled artisan would even go about making such a modification. In short, the references do not appear to enable one skilled in the art to modify the Smith et al. tracking system in the manner contemplated by the Examiner. Specifically, Applicants ask whether the Examiner contemplates that only one file folder would be placed in each slot corresponding to the tape slots in the tape carriers of the Smith et al. system, or whether the Examiner contemplates that more than one folder would be placed in any one slot. If the Examiner contemplates only one folder per slot, Applicants ask why one of ordinary skill in the art would then have been motivated to modify the system to include the specific file folders of Kott, since each slot already provides for an indicator to identify that the requested file folder is in that slot. On the other hand, if the Examiner contemplates more than one file folder per slot, it is not at all clear that the system would still be operational. Specifically, the manner in which the microcontroller within each tape carrier is programmed is dependent upon having only one tape per slot, whereby each of the slots are periodically polled and any tape contained therein transmits its identification signal back to the microcontroller. If more than one folder was contained in any one slot, however, the microcontroller could no longer separately poll each of the file folders. In other words, in response to a polling signal, each of the file folders within the slot would simultaneously transmit their identification codes to the microcontroller, which would ultimately create a garbled signal in which none of the file folder identification codes could be identified.

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Applicants submit that for the same reasons that Applicants are unable to determine how the Examiner contemplates modifying the Smith et al. system to utilize the Kott file folders, one of ordinary skill in the art would not have been motivated to make such an ambiguous modification. Furthermore, the lack of detail as to how the modified system could be constructed clearly underscores the fact that the Examiner is relying on impermissible hindsight to reconstruct the claimed invention.

For the reasons stated above, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 1 as well as claims 12 and 13, which depend therefrom, over the teachings of Smith et al., Kott, and Foster. Accordingly, claims 1, 12, and 13 are allowable over the teachings of these references whether considered separately or in combination.

#### Claim 19

Independent claim 19 recites a file tracking system comprising a database, a processor for interfacing with the database, a bus connected to the processor, an input device for receiving commands and file identification information from an operator and for providing such information to the processor, a plurality of folder retainers each connected to the bus via an addressable switch, a unique address, and a plurality of file folders each including an addressable switch. Claim 19 further recites that when an operator inputs a command to search for a specific file, the processor identifies a first unique address corresponding to the

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file identification information identifying the specific file that is searched for, identifies a second unique address in the database for the addressable switch of the folder retainer in which the searched-for file folder is located, and transmits various control signals including one that includes the second unique address of the addressable switch of the folder retainer and one that includes the first unique address associated with the file folder.

The Smith et al., Kott, and Foster patents do not disclose separately or in combination a file tracking system that would include a processor that performs the above-identified functions. Specifically, even if Smith et al. were modified in accordance with the Kott and Foster teachings, the resultant system would not perform the recited functions. The Smith et al. and Kott references disclose systems whereby a controller issues a *single* identification signal that is associated with the item being searched for. Smith et al. and Kott do not disclose that any other control signals are issued that include a second unique address associated with the tape/folder retainer in which the tape/file folder is located. While Foster discloses a system whereby a control signal is issued that identifies a particular file cabinet so as to activate an indicator on the file cabinet, Foster does not also disclose submitting a control signal that includes the unique address corresponding to the specific file that is being searched for. As explained further below, there would not have been any motivation for one of ordinary skill in the art to have considered modifying the Smith et al. or Kott systems to issue a second control signal including a second unique address associated with a file cabinet.

The Smith et al. system operates on an entirely different premise than that of the present invention or the Foster system. Specifically, in Smith et al., the processor that issues a

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control signal including the file identification information delivers this control signal to *all* of the tape carriers, irrespective of whether they actually contain the requested tape. The various tape carriers use the information in the control signal to compare to a table that lists the tapes that it holds. The tape carrier that holds the requested tape issues a signal back indicating that the requested tape is contained in that tape carrier. Because the processor that issues the control signal identifying the requested tape does not know which tape carrier the requested tape is located in at the time that it issues the control signal, it certainly could not transmit a signal containing a unique address of a particular tape carrier in which the tape is located.

The Kott patent discloses only a single folder retainer, whereby the user enters the file identification information directly into the folder retainer. Because only a single folder retainer is utilized in the Kott device, there would certainly be no need for the processor contained therein to issue a control signal including a unique address of the folder retainer in addition to the address of a requested file folder.

In the Office Action, the Examiner contends that it would have been obvious to utilize multiple addressable cabinets each with an addressable indicator to assist the user in locating a folder in the modified system described in the Office Action. Applicants submit, however, that if one of ordinary skill in the art truly wished to incorporate this function in the modified Smith et al. system, they simply would have had the microcontroller associated with the folder retainer activate its own indicator light when a match had been found, rather than having the requesting processor transmit a second control signal that would cause such an indicator to become activated. In fact, as shown in Fig. 13, the tape carrier microcontroller is coupled to



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an indicator, such as speaker 340, for emitting an audible beep. As clearly described in the corresponding description in the Smith et al. patent, microcontroller 300 activates or deactivates a beeping noise through speaker 340 based upon its own control procedures rather than in response to any particular control signal transmitted from the requesting host processor. Furthermore, indicator lights 32a (Fig. 2) are already provided on the tape carrier and become illuminated when the requested tape is contained therein. Why would one need to add an additional indicator light having its own unique address?

Because the resultant system contemplated by the Examiner would be accomplished without performing the specific function recited in claim 19 (*i.e.*, that of the requesting processor issuing a control signal including a second unique address associated with the identified folder retainer), claim 19 is allowable over the teachings of Smith et al., Kott, and Foster whether considered separately or in combination.

#### Claim 23

Independent claim 23 defines a method of locating a file comprising at least the steps of transmitting a first control signal to a receiver at the present location of a file to be located, where the first control signal includes a unique identification code of the receiver, and transmitting a second control signal to the file to be located, where the second control signal includes a unique identification code of the file. For the reasons stated above with respect to claim 19, Applicants submit that the combined teachings of Smith et al., Kott, and Foster

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would not result in a system where, for a single requested file, two separate control signals are issued that include different unique identification codes, where one corresponds to the file folder to be located and the other corresponds to a receiver positioned at the present location of the file.

As discussed above, there would be no reason why one of ordinary skill in the art would have considered modifying the Smith et al. system so as to have the requesting host processor issue a second control signal to the particular tape carrier/folder retainer that has the requested tape/file, since the tape carrier/folder retainer that has the requested file would be able to determine for itself that it contains the requested file or tape and hence could activate an indicator light or alarm. To the extent that the microprocessor contained in the tape carrier/folder retainer would be issuing a signal to activate the indicator, such a signal would not include a unique address associated with the particular tape carrier/folder retainer. Nor for that matter does there appear to be any reason to modify the resultant system to perform this specific function. Accordingly, Applicants submit that independent claim 23 is allowable over the teachings of Smith et al., Kott, and Foster whether considered separately or in combination.

#### Claim 34

By this Amendment, claim 34 has been amended to recite that the electronic file tracking system further comprises a database for maintaining file identity, file location, and

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unique file addresses for a plurality of files. This same feature was recited in independent claim 34 as originally presented with this application. This Amendment should not affect the grouping of the claims pertaining to the restriction requirement insofar as claim 34 has merely been amended back into its original form as it existed at the time the restriction requirement was made.

Independent claim 34 is directed to an electronic file tracking system comprising a database, a processor, a folder retainer having electrical contacts communicatively coupled to the processor, and a plurality of file folders each including an addressable device adapted to be electrically coupled to the processor when the file folder is placed in the folder retainer. Each folder retainer further includes a conductor located on the file folder and configured so as to electrically couple the addressable device to the electrical contacts of the folder retainer when the file folder is positioned in any one of several different positions. None of the cited references teaches or suggests the latter feature. Specifically, in Smith et al. the tape cartridges do not include conductors that are configured to couple the memory device carried thereon to the contacts in the tape carrier when the tape is positioned in one of several different positions. Clearly, the slots and tape cartridges are dimensioned such that the tape cartridges may not be positioned in the tape carrier in more than one position so that electrical contact could still be made. The Kott reference does not disclose that the electrical contacts on the docket card folders would continue to make contact if the position of the docket card folder were in any different position than that disclosed in the patent. The Foster patent does not

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disclose any form of electrical contact between the file folders and electrical contacts provided in a folder retainer.

For these reasons, Applicants respectfully submit that independent claim 34 is allowable over the teachings of Smith et al., Kott, and Foster whether considered separately or in combination.

#### Claim 54

Independent claim 54 recites a file tracking system comprising a processor, a plurality of folder retainers communicatively coupled to the processor wherein at least one of the folder retainers is configured to support file folders in an orientation different than that in which another folder retainer supports file folders, and a plurality of file folders each including an addressable device adapted to be communicatively coupled to the processor when the file folder is placed in any one of the folder retainers. Independent claim 54 is thus very similar to allowed claims 35-38 insofar as it relates to the ability of the folders to be placed in a variety of different orientations within the folder retainers. For example, the claim recites an inventive feature whereby any single file folder of the plurality may be placed in a file drawer or bookshelf, such that the conductors on the folder surface are generally *perpendicular* to the electrical conductors provided in the bottom surfaces of the file drawer or bookshelf (see Figs. 1 and 6). Additionally, the same file could be placed in a file tray 40 in which the conductors on the surface of the file folder are *parallel* to the electrical conductors 42 and 43. Another example of this aspect of the present invention is illustrated in Figs. 5 and 6, whereby

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the file folder shown in Fig. 5 may be used to make contact with conductors positioned on either the side or bottom surface of a folder retainer.

The Smith et al. reference simply does not relate to file folders, while the Kott and Foster patents do relate to file folders, but require a common orientation with respect to any file folders or file drawers in which the file folders are placed. It is noted that the Examiner did not address the features of claim 54 in the Office Action.

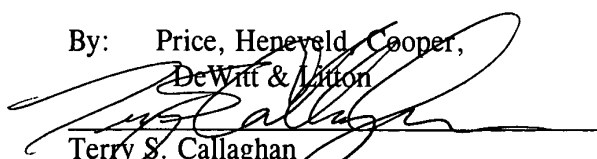
Because none of the cited references teach or suggest this feature of independent claim 54, Applicants submit that claim 54 is allowable over the teachings of Smith et al., Kott, and Foster whether considered separately or in combination.

In view of the foregoing remarks, Applicants submit that the present invention as defined in the pending claims is allowable over the prior art of record. The Examiner's reconsideration and timely allowance of the claims is requested. A Notice of Allowance is therefore respectfully solicited.

Respectfully submitted,

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